REMARKS

This Amendment is responsive to the Office Action identified above, and is responsive in any manner indicated below.

PENDING CLAIMS

Claims 55-60 were pending in the application at the time of the Office Action, under consideration and subject to examination. Additional claims have been added (without prejudice or disclaimer). Such added claims are unrelated to any prior art or scope adjustment and are simply further claims in which Applicant is presently interested. Claims 61-66 substantially parallel Claims 55-60, respectfully, with independent claim 61 having alternative limitations from those of independent claim 55. Claims 67-72 are system claims which substantially parallel apparatus Claims 61-66. At entry of this paper, Claims 55-72 are pending for consideration and examination in the present application.

REJECTIONS UNDER 35 USC §103 - TRAVERSED

At Items 5-9 spanning pages 3-9 of the Detailed Action, the various rejections of Claims 55-60 under 35 USC §103 as being unpatentable over Kramer *et al.* (US 4,667,088)*, Welsh *et al.* (US 4,955,070), Junguji (US 4,847,840), Koguchi *et al.*, (US 5,138,925), Etoh *et al.* (US 5,297,097) and Koenck (US 4,737,702) are respectfully traversed.

All descriptions of Applicant's disclosed and claimed invention, and all descriptions and rebuttal arguments regarding the applied prior art, as previously submitted by Applicant in any form, are repeated and incorporated herein by

reference. Further, all Office Action statements regarding the prior art rejections again are respectfully traversed, including the statements made by apparent judicial (Examiner) notice in the Office Action in support of the art rejections to **assert** that certain claimed features are well known in the art. As Applicant has previously indicated, the Examiner should cite **a reference which factual supports** his position, or withdraw such assertions.

With regard to the requirements to support a rejection under 35 USC §103, such requirements have been clarified in the recent decision in *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002), wherein the Court, in reversing an obviousness rejection, indicated that deficiencies of the cited reference cannot be remedied with conclusions about what is "basic knowledge" or "common knowledge." The Court pointed out:

> The Examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjected belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher."...Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion. (emphasis added)

Applicant's disclosed and claimed invention is directed toward a memory apparatus having a playback circuit removably connected with a digital signal source, to store digital data received from the digital signal source and to reproduce

the digital data stored therein independently of the digital signal source. One example embodiment is the memory apparatus being a personal MP3 player, which can be connected to a publicly-provided MP3 download vending machine. See Applicant's Claim 60, for example.

One important feature of Applicant's disclosed and claimed invention is that Applicant's battery switch enables use of **higher** operating voltage power from the digital signal source (in comparison to the lower voltage level of the apparatus' internal rechargeable battery) during times when the memory circuit stores (*i.e.*, downloads) the digital data while connected to the digital signal source, and to use power from the **lower** voltage internal rechargeable battery when the playback circuit reproduces the digital data in a condition of being removed from the digital signal source.

One advantage of Applicant's disclosed and claimed invention is that Applicant's memory can be operated at a higher frequency as a result of using higher voltage, *i.e.*, Applicant's memory is operable at differing speeds at differing application voltages. See Applicant's Claim 58, for example. Such is advantageous in that it allows any download transaction at an MP3 download vending machine to be conducted in a very short amount of time. Such quickness would boost the attractiveness/transactions of the vending machine so as to maximize profits.

Another advantage is that the higher vending machine (*i.e.*, digital signal source) voltage can be used to quickly charge the lower voltage battery of the personal MP3 player. See Applicant's Claim 59, for example.

Turning now to the applied art, as admitted within the Office Action, the reference to Kramer *et al.* is DEFICIENT in these regards.

The latest of a string of five (5) Office Actions now attempts to combine with Welsh *et al.* to overcome this deficiency. However, the disclosure of Welsh *et al.* is LIKEWISE DEFICIENT in the above regards. More particularly, Welsh *et al.*, AT BEST, only VAGUELY discusses (Column 6, line 23) that battery 162 (FIG. 6) may be a 6 volt battery, and (Column 4, lines 5-6) that base unit 12 "preferably has a connection to conventional household AC electrical power at terminals 38, 40." NOWHERE does Welsh *et al.* discuss what type of voltage is provided through the monitor/base direct electrical connections 32, 34. It seems that 6 volts is the most likely candidate, since to allow the AC electrical power to be applied across the connections 32, 34 would destroy the monitor's circuitry and/or blow up the battery 162.

In short, NOTHING IS EXPLICITLY SAID about the electrical connections 32, 34 voltage, and accordingly, only SPECULATION can be made regarding the same. SPECULATION is NOT SUFFICIENT to support a rejection.

As a further failure, Office Action comments allege that Welsh et al.'s FIG. 6 has a "switch between the battery charger and the power conditioning circuit". However, such is a MISCHARACTERIZATION as Welsh et al.'s FIG. 6 has only a diode between its battery charger and power conditioning circuit.

Given that NEITHER of Kramer *et al.* NOR Welsh *et al.* discloses a battery switch which enables use of **higher** operating voltage power from the digital signal source (in comparison to the lower voltage level of an internal rechargeable battery) during times when the memory circuit stores (*i.e.*, is downloads) the digital data while connected to the digital signal source, and to use power from the **lower** voltage internal rechargeable battery when the playback circuit reproduces the digital data in

a condition of being removed from the digital signal source, it is respectfully submitted that combination of such art would not have resulted in or have suggested Applicant's disclosed and claimed invention.

Moreover, the following additional remarks are submitted by Applicant's foreign representative in support of the patentability of the claims.

The Examiner has rejected independent Claim 55 and dependent Claim 60 relying on the combination of Kramer *et al.* and the newly-cited Welsh *et al.* Claims 56-59 are rejected over the combination of these two patents and further in view of the already-applied references of record.

One of the important features of this invention, as defined in Claim 55, is that the battery switch enables use of power from the digital source having a higher operating voltage than that of the inner (secondary) battery when the memory circuit (of the player 101) stores the digital data in a condition of connecting to the digital source (terminal device 100), and to use the power from the inner battery when the playback circuit reproduces the digital data in a condition of the digital source (see, *e.g.*, page 35 of the specification).

The Examiner asserts that Claim 55 is obvious from the newly-cited reference to Welsh *et al.*, Col. 6, lines 20-33, in combination with Kramer *et al.*

Welsh *et al.* discloses that an inner battery of an on-board power supply of the system is recharged when connected to a base unit 12, and supplies power to the system when it is disconnected from the base unit. However, Welsh *et al.* does not disclose or teach anything about the relation in magnitude between a source voltage (that is, a base unit voltage) and an operating voltage of the battery.

In fact, none of the cited prior art disclose the essential elements of the claimed invention. Therefore, the claimed invention would not be obvious from any combination of the cited references.

As a result of all of the foregoing, it is respectfully submitted that the applied art would not support a §103 obviousness-type rejection of Applicant's claims. Accordingly, reconsideration and withdrawal of such §103 rejections, and express written allowance of all of the rejected claims, are respectfully requested.

(*As in the previous two Office Actions, the patent number given for this reference in the present Office Action is again wrong.)

EXTENSIVE PROSECUTION NOTED

Applicant and the undersigned respectfully note the extensive prosecution which has been conducted to date with the present application.

REQUEST FOR EXAMINER INTERVIEW BEFORE FURTHER ACTION

In the interest of expediting prosecution of the present application, Applicant respectfully requests that an Examiner Interview be scheduled and conducted before any further Action is issued with respect to the present application. The Examiner is respectfully requested to contact the attorney indicated on this paper at the local D.C. area number of 703-312-6600 for the purpose of scheduling such an Examiner Interview. The Examiner is thanked in advance for such considerations. Contact will also be attempted by the undersigned to schedule an Examiner Interview. In the event that the present papers, in and of themselves, are sufficient to place the application in condition for allowance, no Examiner interview would be necessary.

SPE REQUESTED TO ATTEND EXAMINER INTERVIEW

In view of the fact that the assigned Examiner is not of signatory authority, and in view of the extensive prosecution which has already been conducted, it is respectfully requested that the Examiner's Supervisory Primary Examiner (SPE) attend any Examiner Interview.

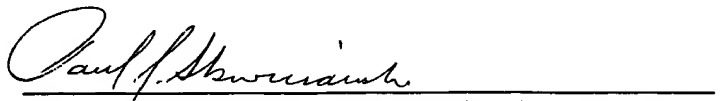
EXAMINER INVITED TO TELEPHONE

The Examiner is invited to telephone the undersigned at the local DC area number 703-312-6600, to discuss an Examiner's Amendment or other suggested action for accelerating prosecution and moving the present application to allowance.

CONCLUSION

This Amendment is being filed within the shortened statutory period for response to the outstanding Office Action, and therefore, no Petition/fee is required. To whatever other extent is actually necessary, Applicant respectfully petitions for an extension under 37 CFR §1.136. Moreover, no additional claim fees are required for entry of this paper. Please charge any actual deficiencies in fees due to ATS&K Deposit Account No. 01-2135 (as Order No. 500.31310CX2).

Respectfully submitted,



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